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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1953

No. 512

MILWAUKEE ELECTRIC TOOL CORPORATION,
A Wisconsin Corporation,
Petitioner,

vs.

ALBERT S. JOHANN,
Respondent.

RESPONDENT'S BRIEF ON MOTION TO DENY PETITION FOR A WRIT OF CERTIORARI TO THE SUPREME COURT OF THE STATE OF WISCONSIN

To The Honorable Earl Warren, Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your Respondent, Albert S. Johann, respectfully prays that application for Writ of Certiorari to review the judgment of the Supreme Court of the State of Wisconsin, dated July 3, 1953, and which the court refused to modify after a motion for rehearing on September 11, 1953, be denied.

JURISDICTION

It is conceded that if this court is to assume jurisdiction in this case, it must do so by authority of 28 U.S.C., Sec. 1257(3).

QUESTIONS INVOLVED

1. Does it affirmatively appear from the record that a federal question has been properly drawn into the case?

2. Does it affirmatively appear from the record, not only that a federal question was presented for decision to the highest state court, but that its decision of the federal question, if any, was necessary to the determination of the case, and was a federal question, if any, actually decided?

3. Do the pleadings draw in issue a federal question; did motions by petitioner in any way present to the highest state court a federal question?

4. Is the judgment presented a final one?

5. Is there an independent ground, not involving a federal question, that is broad enough to sustain the judgment and decision of the Wisconsin Supreme Court?

STATEMENT

Many of the basic facts in this case tending to prove an oral contract and the resultant damages are not in issue.

Respondent does not concede that the patent infringes the early stull patent. The record (T.R. 10) merely indicates that there may have been an "apparent" conflict. Both tools have the same function and generally operate in the same way and are similar in mechanical principle and appearance (T.R. 5-8).

Mr. Siebert, petitioner's president, was informed by his patent counsel in 1945 when the double registration numbers were first applied to the article that it was wrong to make such application (T.R. 11). The petitioner nonetheless deliberately and with intent continued to use both registration numbers on its article (T.R. 6-7).

REASONS FOR DENYING WRIT

This court may take no jurisdiction, in reviewing a decision of a court of a state unless it affirmatively appears from the record that a federal question has been created. This general rule is sound and well founded and is formally stated in Supreme Court Rule 38(5):

> "A review on writ of certiorari is not a matter of right but of sound jurisdictional discretion and will be granted only where there are special and important reasons therefor."

This court then turns to the record to determine whether its discretion in granting the petition should be invoked. How shall this court be guided in its search to determine whether the writ should be granted. Does this record reveal "special and important" reasons? Does this record reveal a statutory question substantial in character and properly raised below:

> "The mere assertion that the case is one involving the construction or application of the constitution, and in which the construction of federal laws is drawn in question, does not, however, authorize this court to entertain the appeal; and it is our duty to decline jurisdiction if the record does not present such a constitutional or statutory question substantial in character and properly raised below." *Corrigan vs. Buckley,* 271 U.S. Rep. 323 (Page 329).
>
> "Before we may undertake to review a decision of the court of the state, it must appear affirmatively

from the record not only that the federal question was presented for decision to the highest court of the state having jurisdiction, but that its decision of the federal question was necessary to the determination of the cause * * * that determination must rest upon an examination of the record."

"It is not enough that the record shows that the plaintiff in error contended and claimed that the judgment of the court impaired the obligation of the contract and violated the provisions of the constitution of the United States, and that this claim was over-ruled by the court; but it must appear, by clear and necessary intendment, that the question must have been raised, and must have been decided, in order to induce the judgment." *Honeyman vs. Hanan,* 300 U.S. Rep. 14 (Pages 18, 19 & 20).

The court may first examine the pleadings. Respondent's complaint shows a simple contract action for money due and owing (T.R. 1-2).

The answer of petitioner shows general and some specific denials with a few routine admissions (T.R. 3).

After the plaintiff had rested its case, the trial court permitted petitioner to amend its answer (T.R. 8-9).

The pleadings reveal not one scintilla directly or by generous implication pertaining to a federal question. If a federal question or issue were contemplated by petitioner, here was the opportunity, in the amended answer, to draw in it such federal question.

At the conclusion of respondent's case, petitioner moved for a non-suit upon the grounds (T.R. 8):

(a) That it was undisputed in the record that no Johann tools were ever manufactured and sold;

(b) Respondent was relying for recovery upon the theory that the affixing of name plates showing

> the number of the Johann patent constituted the Lieber-Beckwith tool a Johann tool, and that in order to reach such conclusion, it was necessary for the plaintiff to establish an estoppel on the part of the defendant which would prevent the defendant from asserting the fact that it would not manufacture and sell Johann tools.

No federal question of any kind is raised here for decision.

At the close of all testimony, petitioner moved for a directed verdict upon grounds (T.R. 13) that say nothing directly or by implication of a federal question presented to the highest state court.

In its decision the trial court mentioned the word "infringement" but not in connection with any federal issue. The court obviously had in mind that it was making its decision on directed verdict only because there were little or no Johann tools manufactured and sold and because it chose to believe that there was an accord and satisfaction (T.R. 14).

Petitioner's witness, Mr. Lieber, petitioner's patent attorney, (T.R. 10) stated vaguely:

> "* * * The Johann hammer apparently conflicted with the claims of the stull patent."

There is no indication in the record that any court actually and definitely found an infringement and no indication that the basic factor to its determination of this cause was anything except the nonproduction of the Johann tool and the accord and satisfaction. The court had no federal question in mind in its decision because none was presented or argued at any time.

It seems rather odd to the respondent that petitioner would use the double marking (including the marking

relating to the Johann tool) if he felt at the time that the Johann tool was infringing the stull tool. It is obvious then that infringement was never in the mind of petitioner before trial, during trial, or at any stage of the appeal to Wisconsin Supreme Court.

The judgment (T.R. 15) brings up no federal question.

The Wisconsin Supreme Court in its decision (T.R. 18) mentions the word infringement but only as referring to possible reasons for petitioner's non-liability on the contract. The Wisconsin Supreme Court did not dwell on infringement because this thought was not an issue, having never been drawn into the case on the basis of any federal issue. The Wisconsin Supreme Court in its decision makes no mention of and relies upon no federal statute or federal issue because none was contemplated and none was presented. The only cases presented to the Supreme Court in briefs, by both parties, were cases that revolved about the applicable law that resulted from the use of the double patent marking by petitioner.

On motion for rehearing in the Wisconsin Supreme Court the petitioner is again conspicuous for its lack of presenting a federal statute or a federal question.

Petitioner makes utterances, that the record fails to substantiate; this court in its minute search of the record will find nothing that should even stir its discretional authority. The decision of this court in 343 U.S. Rep. 250, *Beauharnais vs. Illinois* covers the stated situation:

> "Neither by proffered evidence, request for instructions, nor motions before or after verdict, did the defendant seek to justify his utterance nor has the defendant urged as a ground for reversing his

> conviction in this court that his opportunity to make those defenses was denied below."

The mere assertion by plaintiff that a federal question is present does not ipso facto make it so.

> "The mere assertion that the case is one involving the construction and application of the constitution, and in which the construction of federal laws is drawn in question, does not, however, authorize this court to entertain its appeal." 271 U.S. Rep. 323 (Page 329) *Corrigan vs. Buckley.*

Mere mention of the word infringement in this record, in a nebulous isolated capacity, is not sufficient to set in motion this court's discretionary powers. The record must show something substantial in the way of a federal question. Respondent again invites the court's attention to *Corrigan vs. Buckley,* 271 U.S. Rep. 323 (Page 329), "substantial in character and properly raised below".

The record must, but in this case does not affirmatively, disclose that the validity of a federal statute or a federal issue was drawn into this case for decision. In the *Live Oak vs. Railroad Commission Case,* 269 U.S. Rep. 354, (Page 356) the court uses firm language:

> "Considering the circumstances here disclosed by the record, we have no jurisdiction unless it affirmatively appears that in the court below there was duly drawn in question the validity of the statute of or an authority exercised under the state court of repugnance to the constitution, treaties or laws of the United States."

Federal courts have gone further and stated emphatically that not only must there be an affirmative showing in the record but that a decision of a federal question was necessary to its determination and that it must have been properly brought in.

"We have repeatedly held that it is essential to the jurisdiction of this court in reviewing a decision of a court of a state that it must appear affirmatively from the record, not only that a federal question was presented for decision to the highest court of a state having jurisdiction, but that its decision of the federal question was necessary to the determination of the cause; that the federal question was actually decided or that the judgment as rendered could not have been given without deciding it." *Southwestern Bell vs. Oklahoma,* 303 U.S. Rep. 206 (Page 212-13).

"It is a well established principle that before the Supreme Court will review a decision of a state court, it must affirmatively appear from the record that the federal question was presented to the highest court of the state having jurisdiction, and that its decision of the federal question was necessary to its determination of the cause." *United States vs. Commonwealth of Pennsylvania,* 89 Fed. Supp. 636 (Page 639). (See also *Corrigan vs. Buckley,* 271 U.S. Rep. 323 (Page 329).

This record here is bare not only as to an affirmative showing, but as to necessity of a federal question, if any, to its decision. This record discloses absolutely nothing that refers to a federal question.

"The record does not disclose what, if any, federal questions were presented to the State Supreme Court." *Northwestern Bell vs. Nebraska,* 297 U.S. Rep. 471 (Page 473).

The petitioner may not now contend that somewhere in the record lies concealed a federal question. If it were conceded for argument's sake that somewhere in the record there lies buried and concealed a lifeless federal question, this concession were it so, gives neither petitioner nor the court authority to breathe life into it.

The issue must be substantial. This court should not be required, and will not allow itself, to fumble blindly for a hazy federal question, if any.

> "The benefits of hypothetical defenses, never raised below or pressed upon us, are not to be invoked in the abstract." *Beauharnais vs. Illinois,* 343 U.S. Rep. 250 (Page 264-265).

Respondent respectfully submits that this court in a previous decision used a good genuine choice of words that now, as then, clearly and effectively prescribe the basic rule.

> "It is not enough that there may be somewhere hidden in the record a question which, if it had been raised, would have been of a federal nature." *Mellon vs. O'Neil,* 275 U.S. Rep. 212 (Page 215).
>
> (See also *Corrigan vs. Buckley,* 271 U.S. Rep. 323 (Page 329).

Counsel for respondent has reviewed the cases cited by petitioner with care and takes no issue with their import under a proper record that revealed their connection with the instant case.

McGregor vs. Westinghouse, 329 U.S. 402; *Sola Electric vs. Jefferson Electric,* 317 U.S. 173; *Scott Paper Co. vs. Marcalus Mfg. Co.,* 326 U.S. 249; *Katzinger vs. Chicago Metallic Mfg. Co.,* 329 U.S. 394; *Kenyon vs. Automatic Instrument,* 186 Fed. 2d 752; *United States vs. General Instrument Corp.,* 115 F. Supp. 582.

The afore cited cases revolve about fact situations that bring up directly and put into issue the matter of patent infringement or the validity or invalidity of a patent. It is to be noted in all of these cases the federal issues are raised directly by the pleadings or by other tactical and

legal procedure. In all of these cases federal questions of substance were forthrightly brought to the attention of the court for decision. In these cases the matter of patent infringement or of the validity or invalidity of a patent was either raised by complaint or by answer. It is respectfully submitted that the record with respect to complaint (T.R. 1-2), answer (T.R. 3) and amended answer (T.R. 8-9) lack the issue of patent infringement, validity or nonvalidity of a patent or of any federal question.

This court has on many occasions held that a state court could entertain a suit on a contract that related to or arose from a patent. The following citation by this court states its position effectively and forcefully:

> "The rule is well settled that if the suit be brought to enforce or set aside a contract, though such contract be connected with a patent, it is not a suit under the patent laws * * * ." *Excelsior Wooden Pipe Co. vs. Pacific Bridge Co.,* 185 U.S. 282, 46 Law Ed. 9-10.

It is obvious from a reading of respondent's complaint (T.R. 1-2) that this is a simple contract action arising from the assignment of an article to petitioner that was later patented. No infringement suit was contemplated and, of course, the complaint reveals nothing by the way of infringement. However, petitioner was not barred in the lower court by setting up in his answer (T.R. 3) and his amended answer (T.R. 8-9) the invalidity, if any, of the patent. It is obvious that this the petitioner failed to do and the state court, therefore, had no federal question to decide.

This court has again met this question as follows:

> "There is a clear distinction between a case and a question arising under the patent laws. The former arises when the plaintiff in his opening pleading — be it a bill, complaint, or declaration — sets up a

right under the patent laws as ground for a recovery. Of such the state courts have no jurisdiction, the latter may appear in the plea or answer * * *. The determination of such question is not beyond the competency of the state tribunals." *Henry Pratt vs. Paris Gas Light & Coke Co.,* 168 U.S. 255, 42 Law Ed. 458.

"It is a general rule that a suit by a patentee for royalties under a license or assignment granted by him, or for any remedy in respect of a contract permitting use of the patent is not a suit under the patent laws of the United States and cannot be maintained in a federal court as such." *Luckett vs. Delpark,* 270 U.S. 496, 70 Law Ed. 703.

The record indicates that ours is no infringement case and the rare use of the word "infringement" does not make it so. It was obviously not the intention of either party that that be the issue at the trial or on appeal. At no time was that issue, if any, brought to the attention of the lower state court or the highest state court. Petitioner was represented by skilled and competent counsel. If a federal issue about the validity of a patent were in petitioner's mind, that issue would have been directly stated (T.R. 3) in the answer, and failing that, would have been stated in the amended answer (T.R. 8) three years later. (It is to be noted (T.R. 8) that the amended answer was served and filed during the trial prior to presentation to the court of petitioner's defense).

As a final judgment being presented to the court, the Wisconsin Supreme Court's mandate to the lower court ordered a retrial of issues, revolving about the oral contract and the claimed releases (T.R. 24). The rule is well worded in *Hammerstein vs. Superior, et al,* 341 U.S. 491 (Page 492). In *Montgomery vs. Ledbetter,* 344 U.S. 178 (Page 180):

> "The provision of Section 1257 that only final judgments * * * may be reviewed by the Supreme Court * * * has been carried in almost identical language since the judiciary act of 1789, 1 Stat. 85, Sec. 25. This requirement is not one of those technicalities to be easily scorned. It is an important factor in the smooth working of our federal system."
>
> (See also *Georgia Railway vs. Town,* 262 U.S. 432 (Page 437).

This court has time and again ruled that an entire final judgment must be presented for review — this court in its search for special and important reasons to review a writ should not be handed chips and shreds and asked to fit them together like a jigsaw puzzle. It is obvious that this judgment is not complete as to the subject matter and as to all causes of action involved. This court has clearly spoken in this connection as follows:

> "It is well settled that a case may not be brought here by writ of error or appealed in fragments; that to be reviewable a judgment or decree must be not only final, but complete, that is, final not only as to all the parties but as to the whole subject matter and as to all the causes of action involved; and that if the judgment or decree be not thus final and complete, the writ of error or appeal must be dismissed for want of jurisdiction." *Arnold vs. United States,* 263 U.S. 427 (Page 434).

Assuming that there is a federal question here, this court may inquire as to whether there is independent ground, not involving a federal question, that is broad enough to sustain the judgment of the Wisconsin Supreme Court. Respondent respectfully submits that from the facts as presented — the intentional use of the two registration numbers (T.R. 6-7), and the refusal for three years by petitioner to discontinue using both numbers when advised to do so by his patent counsel, Mr. Lieber

(T.R. 11) (Petitioner's excuse was that it could not obtain metal to make up new tags) (T.R. 11) gave the state court sufficiently broad grounds to sustain its decision. This court has stated the applicable rule many times. The language of the following citation is particularly appropriate:

> "It is well settled that where the Supreme Court of a state decides a federal question in rendering judgment and also decides against the plaintiff in error upon an independent ground not involving a federal question and broad enough to maintain the judgment, the writ of error will be dismissed without considering the federal question." *Browne vs. Union Pacific,* 267 U.S. 255 (Pages 258-259).
>
> (See also *United States vs. Burke,* 90 Fed. Supple 868-871).

The State Supreme Court was asked by petitioner to resolve the following questions only:

(a) Did plaintiff and defendant enter into an oral royalty agreement?

(b) Did the defendant (petitioner here) manufacture and sell any tools which were covered by the invention of the plaintiff (respondent here)?

(c) Was there a written agreement between the parties which constituted an accord of satisfaction?

The State Supreme Court not being asked to decide a federal question accordingly made no decision thereon. The state court decided amongst other things that where a manufacturer deliberately and with intent uses two registration numbers on his article, one number of which describes, identifies and relates to plaintiff's tool, said manufacturer is estopped thereby to deny that the tools bearing such number did not embrace plaintiff's invention (T.R. 24).

The State Supreme Court in arriving at its estoppel decision used as persuasive authority federal cases. This court (United States Supreme Court) has through the years quoted these cases with approval and Wisconsin has now chosen to adopt this law.

The estoppel as decided by Wisconsin Supreme Court is not on the basis of the invalidity of a patent but on the basis only of the double marking.

The Supreme Court of Wisconsin has used and cited with approval the following federal cases that relate to double marking, it being undisputed that the Johann patent (T.R. 5) was in full force and effect during the crucial time period from August of 1945 through December 31, of 1948. (T.R. 6-7).

Singer Manufacturing Company vs. June Manufacturing Company, 163 U.S. 169.

> "Singer's patent on sewing machines had expired — defendant manufactured a sewing machine and on the name-plate attached to its product stamped 'Improved Singer' — plaintiff Singer brings suit to enjoin the defendant from in any way using the word 'Singer' to identify its product."
>
> "Page 183. We conclude that the word 'Singer' was also voluntarily applied by the Singer firm or companies as a designation of the general type of machines made by them with the intention that such machines should be accepted by the public under that name;"
>
> "Page 187. But although we may thus use his name he cannot resort to any artifice or do any act calculated to mislead the public * * *."
>
> "Page 189. Neither has he the right to use any device which may be properly considered a trade mark so as to induce the public to believe that his machine has been manufactured by plaintiff * * *."

Jones vs. Van Kirk, et al. (C.C. Pa. 1865) 13 Fed. Cas. 1039, Case No. 7500.

The only possible answer to the use of the nameplate bearing the double registration numbers is that the licenses were erroneous. However, this the plaintiff is estopped to do.

The defendant stamped certain articles "E. F. Jonas, patent, May 4, 1858" and, subsequently, in an action for royalties due under a license agreement, contended that the articles did not come under the patent. The Court over-ruled this contention saying on page 1040:

> "They thus publicly acknowledged on every lamp sold by them, that it was under Jones' patent."

A similar holding is found in *Horlick's Food Co. vs. Elgin Milkine Co. et al.* (C.C.A. 7, 1903) 120 Fed. 264.

In that case the plaintiff stamped its commercial packages to Horlick's Malted Milk with the words "Patented June 5, 1883". After the expiration of the patent, a competitor began using the phrase "malted milk" in describing a granulated milk food product, calling it "Meadows Malted Milk". Horlick claimed that this was unfair competition and a violation of its trade-mark rights. The defendant responded stating that the trade-mark rights had been lost with the expiration of the patent. The court held that Horlick was estopped to deny that the product was manufactured under plaintiff's patent, stating, page 266:

> "It matters not in our judgment that the patent may not in fact have been valid; nor that the product * * * could not in fact have been covered by the description of the patent. The point is that appellant chose to mark its product as if it were a monopoly thereby obtaining measurably at least the benefit of a monopoly and gave to it a name * * *. The case is thus brought in our judgment within the principle

if not the exact facts of the Singer-June case and must be ruled accordingly."

Another case estopping a party from contending that his marking was erroneous is the case of *Collis Co. vs. Consolidated Machine Tool Corporation of America* (C.C.A. 8, 1930) 41 F. (2d) 641, Certiary Denied. 282 U.S. 886.

Similar authorities include *Sproull vs. Pratt & Whitney Co.*, 97 Fed. 807, 809.

I. "A license to manufacture and sell articles under a number of patents owned by the licensor during the unexpired term thereof * * * where the articles related to the same art, and were ordinarily used co-jointly, is an entire agreement for a single license and binds the licensee to pay the royalty stipulated on all the articles manufactured and sold during the time any one of such patents remains in force."

II. "A licensee who agreed to manufacture an article under a certain patent who stamped the article with the date of such patent * * * is estopped to set up as a defense to a claim for further royalties that the article as made was not covered by the patent."

A similar authority is *Andrews vs. Landers, et al*, 72 Fed. 666.

Said the court on page 670, "As to the so called 'Andrews faucets' I hold as a matter of law that defendant having stamped said faucets with the Andrews patent * * * is estopped to deny that they do not contain the patent improvement of Andrews."

The mere fact that the state court used federal decisions as persuasive authority does not, ipso facto, make of this transaction a federal question.

On page 5 of petitioner's application for a writ, there is cited 35 U.S.C. 287; this section deals with the giving

of notice to the public by the affixing of a patent number to the particular object. Respondent fails to see the materiality of this section to our transaction. The pertinent part of this act reads:

> "Patentees and persons making or selling any particular article for or under them may give notice to the public * * *."

There is nothing mandatory about this section as to notice. It plainly uses the word "may". Petitioner was in no way compelled to use either or both of the particular numbers involved; it chose to do so at its peril.

Page 5 of the petition cites also 35 U.S.C. 292. This is better known as the false marking statute. There is no question here of false marking at all. Petitioner had title to the patent covering the Johann article (T.R. 5). It had an undisputed right to use the Johann Patent Number 2260264 (T.R. 5) but when it did, in the way that it did, petitioner was holding out to the public that he was selling the Johann tool. Yet on Page 5 of petition, petitioner asserts that the Supreme Court of Wisconsin interprets these two sections. Respondent has searched the entire record, including opinion and decision of the Wisconsin Supreme Court (T.R. 17) and finds nothing that even remotely bears on the matter of deciding or interpreting a federal question directly or inferentially.

The Respondent moves that the Petition for a Writ of Certiorari be denied.

Respectfully submitted,

CARL FLOM and
EDWARD S. GRODIN,
Attorneys for Respondent.